

ESTTA Tracking number: **ESTTA740146**

Filing date: **04/14/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SBE Hotel Licensing, LLC		
Entity	limited liability company	Citizenship	Nevada
Address	3900 Paradise Rd., Suite 260 Las Vegas, NV 89169 UNITED STATES		

Attorney information	LEE J. EULGEN NEAL, GERBER & EISENBERG LLP 2 North LaSalle Street, Suite 1700 CHICAGO, IL 60602 UNITED STATES leulgen@ngelaw.com, knye@ngelaw.com, temanuelson@ngelaw.com, dnadolski@ngelaw.com, ECFDocket@ngelaw.com Phone:312.269.8000		
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Applicant Information

Application No	86839754	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Luxe Hospitality Company 11461 Sunset Boulevard Los Angeles, CA 90049 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Hotel services

Applicant Information

Application No	86839748	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Luxe Hospitality Company 11461 Sunset Boulevard Los Angeles, CA 90049 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Hotel services

Applicant Information

Application No	86839736	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Luxe Hospitality Company 11461 Sunset Boulevard Los Angeles, CA 90049 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Hotel services

Applicant Information

Application No	86839726	Publication date	03/15/2016
Opposition Filing Date	04/14/2016	Opposition Period Ends	04/14/2016
Applicant	Luxe Hospitality Company 11461 Sunset Boulevard Los Angeles, CA 90049 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Hotel services

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is generic	Trademark Act section 2(e)(1)
Related Proceedings	United States District Court for the Central District of California, Case No. 2:15-cv-07115-JAK
Attachments	Notice of Opp re LUXE HOTELS RESORTS LUXE COLLECTION LUXE CLUB and EXCLUSIVELY LUXE_.pdf(16137 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Lee Eulgen/
Name	LEE J. EULGEN
Date	04/14/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SBE HOTEL LICENSING, LLC)	
)	
Opposer,)	
v.)	Opposition No. _____
)	
LUXE HOSPITALITY COMPANY, LLC)	
)	
Applicant.)	

CONSOLIDATED NOTICE OF OPPOSITION

This Consolidated Notice of Opposition is submitted in the matter of Application Serial Nos. 86839754 covering LUXE HOTELS & RESORTS, 86839748 covering LUXE COLLECTION, Serial No. 86839736 covering LUXE CLUB, and 86839726 covering EXCLUSIVELY LUXE, each filed by Luxe Hospitality Company, LLC (“Applicant”) for use in connection with “hotel services” in International Class 43. The subject applications were published for opposition in the Official Gazette on March 15, 2016. SBE Hotel Licensing, LLC, a limited liability company organized under the laws of Nevada with a place of business at 3900 Paradise Rd., Suite 260, Las Vegas, Nevada (together with its affiliates, “sbe”) believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. sbe is a global hospitality and entertainment company which owns, manages, and operates a collection of award-winning hotels, residences, restaurants, and nightlife destinations. sbe has achieved tremendous notoriety and success in its field, including in the hotel industry.

2. Applicant has claimed trademark rights in the word “LUXE” and has alleged that sbe’s registered mark, “SLS LUX,” infringes upon Applicant’s rights in its purported marks for the word “LUXE.” Specifically, Applicant filed suit against sbe in the United States District Court for the Central District of California, Case No. 2:15-cv-07115-JAK (the “Federal Litigation”), alleging trademark infringement and unfair competition. sbe has filed counterclaims in that action, alleging, among other things, that Applicant’s asserted LUXE marks should be cancelled on the grounds that they are merely descriptive or generic, and for a declaratory judgment of non-infringement.

3. Now, in an attempt to further constrain sbe and others in the industry, Applicant has filed four additional applications to register designations comprised of LUXE, namely Application Serial Nos. 86839754 covering LUXE HOTELS & RESORTS, 86839748 covering LUXE COLLECTION, Serial No. 86839736 covering LUXE CLUB, and 86839726 covering EXCLUSIVELY LUXE (collectively, the “Subject Designations”).

4. “Luxe” is a commonly used descriptive term, and is defined as meaning “luxurious,” “deluxe,” “elegance,” “sumptuousness,” and “luxury.”

5. Each of the Subject Designations accordingly merely describes purported qualities or characteristics of Applicant’s hotel services offered or planned to be offered in connection therewith.

6. The Subject Designations do not require any exercise of the imagination to be understood as describing purported qualities or characteristics of Applicant’s hotel services.

7. None of the Subject Designations have acquired secondary meaning, and none are inherently distinctive.

8. The Subject Designations are merely descriptive of Applicant's services, and registration of the Subject Designations should therefore be denied.

9. "Luxe" is a generic adjective used to describe hotel services, and not to identify Applicant as the provider of those services.

10. The word "Luxe" has been used by the relevant public and third parties for decades to describe high-end hotel brands and the services that they offer.

11. The relevant public understands that the Subject Designations are generic terms for a luxurious hotel brand and its services.

12. The relevant public associates each of the Subject Designations with an entire class of products or services and does not associate Applicant or any other entity as the source of products or services bearing those designations.

13. The Subject Designations are generic for Applicant's services, and registration of the Subject Designations should therefore be denied.

14. In light of Applicant's assertion of rights against sbe in the Federal Litigation, sbe reasonably believes that it will be damaged by the registration of the Subject Designations.

WHEREFORE, sbe requests that the registrations sought by Applicant be refused and that this Notice of Opposition be sustained.

Respectfully submitted,

Date: April 14, 2016

By: /Lee J. Eulgen/
One of the Attorneys for Opposer,
SBE Hotel Licensing, LLC

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CERTIFICATE OF SERVICE

I, Katherine Dennis Nye, an attorney, state that, pursuant to 37 CFR §§ 2.101 and 2.119, I caused a copy of the foregoing Notice of Opposition to be served upon:

DANIEL P. MULLARKEY
NOVAK DRUCE CONNOLLY BOVE + QUIGG, LLP
1875 EYE STREET NW, 11TH FLOOR
WASHINGTON, DC 20006

via First Class Mail, postage prepaid, on April 14, 2015.

/Katherine Dennis Nye /
Katherine Dennis Nye